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13 *Rakuten Rewards and Cartera Commerce, Inc.*

14
15 **UNITED STATES DISTRICT COURT**
16 **NORTHERN DISTRICT OF CALIFORNIA**
17

18 EBATES PERFORMANCE MARKETING,
19 INC. d/b/a RAKUTEN REWARDS and
20 CARTERA COMMERCE, INC.,

21 Plaintiffs,

22 v.

23 MYMAIL, LTD.,

24 Defendant.

CASE NO. 20-cv-04768-LHK

**DECLARATION OF JOSHUA L. RASKIN IN
SUPPORT OF PLAINTIFFS' OPPOSITION TO
DEFENDANT'S MOTION TO DISMISS THE
COMPLAINT UNDER 28 U.S.C. § 2201 AND
FRCP RULE 4(k) (as Revised 8/17/20)**

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CASE NO. 20-cv-04768-LHK

DECLARATION OF JOSHUA L. RASKIN IN SUPPORT OF PLAINTIFFS'
OPPOSITION TO DEFENDANT'S MOTION TO DISMISS

1 I, Joshua L. Raskin, declare as follows:

2 1. I am an attorney at law duly licensed in the State of New York, and am a shareholder of the
3 law firm of Greenberg Traurig, LLP, attorneys of record for Plaintiffs Ebates Performance Marketing, Inc.
4 d/b/a Rakuten Rewards (“Rakuten Rewards”) and Cartera Commerce, Inc. (“Cartera”) (collectively,
5 “Plaintiffs”) in the above-entitled action, and make this declaration in support of Plaintiffs’ Opposition to
6 Defendant’s Motion to Dismiss (Dkt. 29-1). Unless otherwise stated, I have personal knowledge of the
7 facts set forth in this declaration, and if called as a witness, could and would competently testify as set
8 forth below.

9 2. On June 12, 2020, Defendant MyMail, Ltd. (“MyMail”), through its counsel, Mr.
10 Christopher Michaels, sent a letter to Ebates, Inc. d/b/a Rakuten (“Rakuten”), alleging that the Rakuten
11 Rewards “Chrome extension called ‘Rakuten: Get Cash Back For Shopping’” button (“Rakuten Rewards
12 Button”) infringes claims 1, 5, 9, and 17 of U.S. Patent No. 9,021,070 (“the ’070 patent”), claims 1 and 24
13 of U.S. Patent No. 8,275,863 (“the ’863 patent”), claim 1 of U.S. Patent No. 9,141,263 (“the ’263 patent”),
14 and claim 5 of U.S. Patent No. 10,228,838 (“the ’838 patent”) (collectively, “Asserted Claims”). (Dkt. 1-
15 5 (“Rakuten Rewards Letter”).) Rakuten Rewards is a wholly owned subsidiary of Rakuten.

16 3. On June 12, 2020, MyMail, through Mr. Michaels, sent a very similar letter to Delta
17 Airlines, Inc. (“Delta”), alleging that the “SkyMiles Shopping button,” available at
18 www.skymilesshopping.com, infringes the same Asserted Claims. (Dkt. 1-6 (“Cartera Letter”).) Delta is a
19 customer and business partner of Cartera. Cartera licenses to and operates for Delta the technology
20 underlying the “SkyMiles Shopping button” (hereafter, the “Cartera Button”). Cartera is obligated to
21 defend Delta against infringement claims made with respect to the Cartera Button.

22 4. The Rakuten Rewards and Cartera Letters state that they “serve as a notice of infringement”
23 of the Asserted Claims. (Dkt. 1-5, 1-6.) In addition, they state that “MyMail has been involved in a lot of
24 litigation and has litigators actively enforcing its patents...” (*Id.*) Further, the letters state that MyMail is
25 offering a “license agreement in the form attached to this letter.” (*Id.*) The letters conclude by stating that
26 “[t]he offer to license described above will terminate” if a response is not received by June 24, 2020, after
27 which Mr. Michaels “will turn [his] files over to litigation counsel.” (*Id.*)

28 5. On June 23, 2020, I contacted Mr. Michaels via telephone and requested an additional 30

1 days to respond to the Rakuten Rewards and Cartera Letters. While Mr. Michaels could not commit to any
2 extension, he agreed to recommend to his client that they refrain from turning the case over to “litigation
3 counsel” for another week (i.e., until the following Friday). He also reiterated his warnings that, if Rakuten
4 did not enter into a license, MyMail would be turning the case over to litigation counsel.

5 6. During the June 23, 2020 call, I also explained to Mr. Michaels that Delta is one of several
6 Cartera partners which use the licensed Cartera Button. I did not identify any of the other Cartera partners
7 by name. Because each of Cartera’s partners uses the same Cartera Button, I suggested that Mr. Michaels
8 not send additional enforcement letters to Cartera’s other partners. Contrary to the Declaration of
9 Christopher Michaels (Dkt. 28-2), I did not “ask if MyMail would agree to not contact Delta Airlines, Inc.
10 and other companies related to Rakuten while we negotiated a license.” (Dkt. 28-2, ¶28.) The suggestion
11 not to contact other Cartera partners was not tied to any agreement to negotiate a license.

12 7. On July 2, 2020, I contacted Mr. Michaels again via telephone to let him know that I would
13 be sending a letter on behalf of my clients in response to the Rakuten Rewards and Cartera Letters.
14 Following this call, that same day, I sent the letter. (Dkt. 1-7.) The July 2, 2020 letter concludes by stating
15 that “before commencing any licensing discussions, please let us know your thoughts on the [issues raised
16 in this letter].” (*Id.*)

17 8. On July 10, 2020, I spoke with Mr. Michaels again. During that call, he said that he would
18 be sending a response to my July 2 letter *that same day*. However, he never sent a response—on that day
19 or any time thereafter.

20 9. Having not received a response to the July 2 letter, and concerned about Mr. Michaels’
21 repeated warnings that he would be turning the case over to litigation counsel if Rakuten did not agree to
22 a license, on July 16, 2020, Plaintiffs brought this action seeking a declaratory judgement that the Rakuten
23 Rewards Button and the Cartera Button do not infringe any claim (including the Asserted Claims) of the
24 ’070 patent, the ’863 patent, the ’263 patent, and the ’838 patent. That same day, I sent a courtesy copy of
25 the Complaint to Mr. Michaels.

26 10. Following receipt of Mr. Michaels’ email dated July 16 (Dkt. 29-2), on that same day, I sent
27 an email response, a copy of which is attached as Exhibit A. In my email, I stated, in relevant part:

28 Your email below mischaracterizes our prior communications. I never assured you that

1 my client wished to pursue licensing rather than litigation, and my objective was not to
2 buy time to litigate. In fact, I told you just the opposite, both in my July 2 letter and on
3 our two phone calls. Specifically, in my letter I stated in no uncertain terms that “before
4 deciding whether and to what extent they will engage in licensing discussions with
5 MyMail, Rakuten requests that you address the issues raised [in the letter].” Then,
6 during our call on Friday, I again told you that Rakuten would not engage in any
7 licensing discussions until you responded to our letter. You told me that you would send
8 a response that same day, but never did so. Therefore, based on your repeated threats
9 that, unless Rakuten agrees to a license (for which you have asked more than \$37mm)
10 you “will turn [your] files over to litigation counsel,” our client had no choice but to file
11 suit.

12 11. Mr. Michaels’ statement in his declaration that “[I] also knew that MyMail had not engaged
13 litigation counsel to bring an action against any of [my] clients” (Dkt. 28-2, ¶31) is not true. Mr. Michaels
14 repeatedly told me, both in his letters and on our calls, that the matter would be turned over to MyMail’s
15 litigation counsel if a license agreement was not reached.

16 I declare under penalty of perjury that the foregoing is true and correct.

17 DATED: August 28, 2020

18 /s/ Joshua L. Raskin
19 Joshua L. Raskin

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DATED: August 28, 2020 /s/ Nicholas A. Brown

Nicholas A. Brown

EXHIBIT A

From: Raskin, Joshua L. (Shld-NY-IP-Tech)
Sent: Thursday, July 16, 2020 9:50 PM
To: Christopher Michaels
Cc: Kassenoff, Allan (Shld-NY-IP-Tech); Chris Joe
Subject: RE: Rakuten v. MyMail

Categories: Stingray

Chris:

Your email below mischaracterizes our prior communications. I never assured you that my client wished to pursue licensing rather than litigation, and my objective was not to buy time to litigate. In fact, I told you just the opposite, both in my July 2 letter and on our two phone calls. Specifically, in my letter I stated in no uncertain terms that “before deciding whether and to what extent they will engage in licensing discussions with MyMail, Rakuten requests that you address the issues raised [in the letter].” Then, during our call on Friday, I again told you that Rakuten would not engage in any licensing discussions until you responded to our letter. You told me that you would send a response that same day, but never did so. Therefore, based on your repeated threats that, unless Rakuten agrees to a license (for which you have asked more than \$37mm) you “will turn [your] files over to litigation counsel,” our client had no choice but to file suit.

With that being said, I think it makes sense for us to speak next week. Tuesday at 11 a.m works for me so I will call your office then.

Josh

Joshua L. Raskin
Shareholder; Chair, NY IP & Technology Group

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From: Christopher Michaels [mailto:michaels@bpmlegal.com]
Sent: Thursday, July 16, 2020 7:38 PM
To: Raskin, Joshua L. (Shld-NY-IP-Tech) <raskinj@gtlaw.com>
Cc: Kassenoff, Allan (Shld-NY-IP-Tech) <KassenoffA@gtlaw.com>; Chris Joe <chris.joe@bjciplaw.com>
Subject: Re: Rakuten v. MyMail

EXTERNAL TO GT

Josh:

You requested as a courtesy that we hold off accusing your client’s other customers and in good faith we did so.

You called me several times to make sure we understood your communications in context and to assure me that your client wished to pursue licensing rather than litigation. It seems that your objective was not to negotiate in good faith but rather to buy time to go to litigate in a forum of your choosing. Such behavior works once.

We can discuss by phone next week if you like and I am widely open next Tuesday or Wednesday, but would prefer Tuesday at 11:00am if that works for you. If your client has an offer, please come prepared to convey it.

Chris

Christopher A. Michaels
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Ithaca, NY 14850
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(607) 256-3628 (fax)
www.bpmlegal.com

On Jul 16, 2020, at 6:31 PM, "raskinj@gtlaw.com" <raskinj@gtlaw.com> wrote:

Dear Chris,

Attached is a courtesy copy of a complaint filed today by Rakuten Rewards and Cartera against MyMail in ND Cal. Please let me know if/when you are available next week to discuss. I am generally available on Tuesday and Wednesday.

Thanks,

Josh

Joshua L. Raskin
Shareholder; Chair, NY IP & Technology Group

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<image001.png>

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<2020.07.16 [001] Complaint for Declaratory Judgment of Noninfringement of Patent.pdf>